



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,004	11/28/2001	Christopher A. Julian	017516-002580US	3890

7590 12/02/2005

PATENT DEPT  
INTUITIVE SURGICAL, INC  
950 KIFER ROAD  
SUNNYVALE, CA 94086

EXAMINER

JACKSON, GARY

ART UNIT	PAPER NUMBER
----------	--------------

3731

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/998,004	JULIAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gary Jackson	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims


- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 19-22, 24-30, 33-38, 40, 42-44, 47-53, 55-57, 60-76, 78, 80-87, 103-109 and 111-149 is/are allowed.
- 6) ☒ Claim(s) 1 and 3-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.



#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Continuation of Disposition of Claims: Claims pending in the application are 1,3-17,19-22,24-30,33-38,40,42-44,47-53,55-57,60-76,78,80-87,103-109 and 111-149.

### **DETAILED ACTION**

This action is responsive to applicants' amendment filed September 7, 2005. The amendment is deemed to overcome the rejection set forth in the Office Action mailed June 8, 2005, however, it does not place the application in condition for allowance. After reconsideration, claim 1 as written still reads of the disclosure of US Patent 6,464,691 of record. The rejection is repeated as set forth in the Official Action mailed November 17, 2004.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Castaneda et al (US Patent 6,464,691). The patent to Castaneda et al discloses a tissue stabilizer having first and second toe portions rotatably adapted for insertion into an endoscope. See figure 21. Concerning claim 3, giving the phrase "ring mount" giving the broadest interpretation, many of the elements in Figure 19 are considered "ring mounts" For instance element 530 is considered a "ring mount".

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3 -16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castaneda et al in view Boone et al (US Patent 6,740,028). The patent to Boone et al teaches the use of an adjustable "ankle coupling" that allow for manipulation of the toe

portions. The latter reference also utilizes a series of interlocking balls that allow for adjustment of the foot portions. Boone further suggests irrigation and suction lumens ports for the device. The Castaneda et al and Boone et al combination suggest each of the limitations recited in the claims above. It would have been obvious to one having ordinary skill in the art to modify Castaneda et al with articulating balls that house the split balls as suggested by Boone et al. Further, Castenada et al broadly teaches split ball assemblies in figures 17 and 19.

The above claims were not clearly address by the examiner in the previous Office Action. Therefore, the rejection of these claims is repeated as forth in Office Action mailed November 17, 2004.

***Allowable Subject Matter***

Claims 17, 19-22, 24-30, 33-38, 40, 42-44, 47-53, 55-57, 60, 75-76, 78, 80-87, 103-109 and 111-149 are allowable over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Jackson whose telephone number is (571) 272-4697. The examiner can normally be reached on Mon.-Thurs. 7:30 am to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary Jackson  
Primary Examiner  
Art Unit 3731

A handwritten signature in black ink, appearing to read "Gary Jackson", written over the printed name.

gj  
November 28, 2005